

- W.E.
4. A device for securing knives according to claim 1 or 2 wherein the magnet support is comprised of flexible vinyl, plastic or other flexible material.
5. A device for securing knives according to claim 2 wherein the interior face is comprised of flexible vinyl, plastic or other flexible material.
6. A device for securing knives according to claim 1 or 2 wherein the magnet support extends further beyond one magnetically charged face than the other magnetically charged face, to facilitate opening.
7. (Withdrawn.) A device for securing knives according to claim 1 or 2 wherein the magnet support has a design affixed to the exterior surface of the magnet support.
- Sub B57
8. (Amended.) A device for securing knives according to claim 1 or 2 wherein the magnet support and the central hinge are comprised of a single piece of flexible vinyl, plastic or other flexible material.
- N.E.
9. A device for securing knives according to claim 1 or 2 wherein all materials used in the device are capable of being cleaned, sanitized or sterilized.

REMARKS - GENERAL

The claims have been amended to correct the rejection under 35 U.S.C. § 112, as suggested by the Examiner. In addition, the claims have been amended to more accurately describe the invention, and distinguish the invention over the prior art. The specification has been amended to include language that was in the claims.

Claims Rejection - 35 U.S.C. § 112 Rejection

Applicant has made the changes suggested by the Examiner in the Office Action.

Claims Rejection - 35 U.S.C. § 102(b)

The Office Action rejected Claims 1-6, 8 and 9 as being anticipated by Berglöf et al. (U.S. Pat. No. 5,682,653) (hereafter "Berglöf"). Applicant requests reconsideration of this rejection for the following reasons.

The invention described in Berglöf is different than Applicant's invention in several significant ways. The Berglöf invention requires more parts than Applicant's invention. In addition, the Berglöf invention involves more manufacturing steps because it requires magnetic pole alignment.

Berglöf requires the use of a "magnetic attraction member" (see e.g. Berglöf, Col. 2, line 2). The magnetic attraction member as described in Berglöf, and shown in the drawings, is an assembly with a backing plate (see e.g. Berglöf, Col. 2, line 7). The backing plate is described as a "magnetically soft material" that is positioned behind the magnets. This assembly (made of the backing plate and two permanent circular magnets) is then inserted in a tubular sheath. Every embodiment described in Berglöf includes a magnetic attraction member, and therefore requires the use of a backing plate. The backing plate is essential to the Berglöf invention. Significantly, Applicant's invention does not require a backing plate.

Berglöf apparently requires a backing plate to keep the permanent magnets in place during manufacture. See e.g. Berglöf, Col. 2, lines 7-18. See also Berglöf, Col. 2,

lines 37-38 (describing inserting the backing plate and magnet assembly into the end of the shrink tubing).

By contrast, in Applicant's invention, the magnets adhere to the magnet support through the use of adhesive, heat seal or thermal bond. Alternatively, in Applicant's invention, the magnets are sealed in place inside the magnet support. None of Applicant's embodiments require the use of a backing plate. Applicant's invention requires only the use of a magnet. Applicant's invention is simpler and easier to produce than the invention described in Berglöff.

Berglöff has another feature that makes that invention more complex than Applicant's. Berglöff requires the use of a pair of circular permanent magnets placed side by side with a specific magnetic placement (see e.g. Berglöff, Col. 2, lines 10-14). Applicant's invention does not require any particular placement of the magnetic poles of the magnets.

In Berglöff, the circular magnets are placed next to the backing plate, and are part of the magnetic attraction member. According to Berglöff, it is imperative that the magnetic poles of the circular magnets be opposite. That is, one circular magnet must have its north pole facing the backing plate, and the other circular magnet must have its south pole facing the backing plate. (See e.g. Berglöff, Col. 2, lines 14-17). To further complicate the Berglöff invention, the magnetic poles of the circular magnet must be attracted to the magnetic poles of the magnets in the opposite magnetic attraction member. That is, the north pole of one circular magnet on side one of the device must be magnetically attracted to the south pole of one circular magnet on the other side of the device.

This requirement, that the magnetic poles of four circular magnets be exactly lined up, make the Berglöff invention much more complicated to manufacture than Applicant's invention. Applicant's invention does not require any specific placement of the magnetic poles.

Furthermore, Applicant's invention is not a clamp, like Berglöff's. Berglöff states that the invention has "two magnetic attraction members which attract one another magnetically *through* an interposed object . . ." (Berglöff, Col. 1, lines 2-4, emphasis added.) Berglöff requires that the magnets attract each other, so that they operate as a clamp to clamp onto clothing or other materials. In Applicant's invention, the magnets are magnetically attracted to the knife blade. Therefore, although the magnets may attract one another, Applicant's invention does not require the magnets to be magnetically attracted to each other. It is sufficient that the magnets attract to and secure the knife blade.

Berglöff also requires the use of shrink tubing to entirely enclose the magnetic attraction members. This is the only embodiment described by Berglöff. Applicant's invention does not require the use of shrink tubing to entirely enclose the magnets (although shrink tubing could be used).

First, it is significant that in one embodiment described by Applicant (and shown in Figs. 2 and 3) the magnets are not completely sealed. Every embodiment described by Berglöff shows that the magnets are entirely encased in the shrink tubing. This is because Applicant's invention may use adhesive, heat sealing or thermal bonding to adhere the magnets to the magnet support.

Second, even in Applicant's embodiments in which the magnets are entirely enclosed, the method of enclosing the magnets is different than the method required by Berglöf. Applicant describes using adhesive or sealant to seal the four sides of the magnet support. (Application, page 4, lines 23-27.) Applicant also describes using a heat seal, that is, a thermal bond. A heat seal is not the same as a shrink tubing. As described in Berglöf, the shrink tubing is heated and shrinks to hold the magnetic attraction members in place. (See Col. 2, lines 22-27.) A heat seal involves the application of heat on the edges of the device to seal the edges. A heat seal does not involve shrinking plastic. It simply seals the plastic (or other material) through the use of heat.

Finally, Applicant's invention requires only one magnet on each side of the device. Berglöf requires two circular magnets on each side of the device. Once again, Applicant's invention is easier to manufacture, and has fewer parts than the Berglöf invention.

Claim Rejection - 35 U.S.C. § 103(a)

The Office Action rejected Claim 7 under 35 U.S.C. § 103(a). Claim 7 claims a design on the exterior of the device. The Office Action states that Berglöf shows all of the claimed structure except the design, but that the design is not patentably distinct.

Applicant is withdrawing Claim 7 from consideration. Therefore the objections noted in the Office Action are no longer applicable.

Prior Art References Listed in Office Action

Applicant has reviewed the prior art citations listed as art of interest. None of these citations describe Applicant's invention, nor do they render it obvious.

37 CFR 1.118 Amendment

37 CFR 1.118(a) states that:

"All amendments to the specification, including the claims and the drawings filed after the filing date of the application must conform to at least one of them as it was at the time of the filing of the application."

Thus, 37 CFR 1.118(a) allows an amendment of the specification when something is described in the claims. As explained in MPEP 2163.06 "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

Claim 3 in the Application claims magnetically charged faces comprised of "lightweight or flexible magnets." However, flexible magnets are not mentioned in the specification, apparently due to an editing error. Please amend the specification at page 4, lines 6-7 to read as follows.

"The magnetically charged faces 10 are preferably made from lightweight or flexible magnets."

Claim Amendment

Applicant is also amending Claim 3 to comply with the requirements of MPEP 2173.05(h). The unamended version of Claim 3 states that the "magnetically charged faces are comprised of lightweight or flexible magnets." According to MPEP 2173.05(h), this language is incorrect. "It is improper to use the term 'comprising' instead of 'consisting of.'" MPEP, 2173.05(h), citing *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980).

In order to fully comply with the MPEP requirements, Applicant is amending Claim 3 to read as a proper "Markush" claim.

Attachment

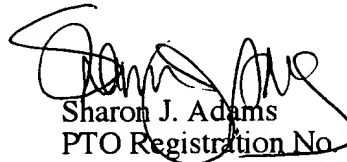
Attached hereto is a marked-up version of the changes made to the claims and the specification by the current amendment. The attached page is captioned "Version With Markings to Show Changes Made."

Conclusion

Based on the foregoing reasons, Applicant respectfully submits that the errors in Claims 1 and 8 have been corrected to comply with 35 U.S.C. § 112. Applicant further respectfully submits that Claims 1-6, 8 and 9 are allowable over the cited reference, were not anticipated by Berglöf, and are allowable under 35 U.S.C. § 102. Applicant's invention describes and claims a magnetically charged face made of a single magnet. Berglöf describes a magnetic attraction member made of a backing plate and two, magnetically aligned, circular magnets. Applicant's invention is distinct from the Berglöf patent. Finally, Applicant is withdrawing Claim 7, and therefore the objections to Claim 7 under 35 U.S.C. § 103 are no longer applicable.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Very truly yours,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE**In the specification;**

Paragraph beginning at line 6 of page 4 has been amended as follows

Referring to the drawings, there are two magnetically charged faces 10. The magnetically charged faces 10 are preferably made from lightweight or flexible magnets.

In the claims:

Claim 1 has been amended as follows:

1. (Amended.) A ~~device~~ device for securing knives comprising two magnetically charged faces, each magnetically charged face made of a magnet, and each magnetically charged face moveably attached to each the other magnetically charged face by a magnet support with a central hinge, wherein, when in the closed position, the magnetically charged faces cover all, or a part of, ~~the~~ a knife blade, thereby securing and protecting the knife blade.

Claim 3 has been amended as follows:

3. (Amended.) A device for securing knives according to claim 1 or 2 wherein the magnetically charged faces are ~~comprised~~ made from the group consisting of lightweight or flexible magnets.

Claim 7 has been canceled.

Claim 8 has been amended as follows:

8. (Amended.) A device for securing knives according to claim 1 or 2 wherein the magnet support and the central hinge are comprised of a single piece of flexible vinyl, plastic or other flexible material.